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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,665	01/26/2004	Kaoru Taneichi	F-8120	8787

28107 7590 01/05/2007
JORDAN AND HAMBURG LLP
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NEW YORK, NY 10168

EXAMINER

SAETHER, FLEMMING

ART UNIT	PAPER NUMBER
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3677

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/764,665	TANEICHI, KAORU	
	Examiner	Art Unit	
	Flemming Saether	3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6,8,9 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,5,6,8 and 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election Restriction

Claims 4 and 9 remain in the application as withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 5, 6 and 8 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Meredith (US 5,655,936) in view of Weddendorf (US 5,340,252) and further in view of Mehlberg (US 5,842,894). Meredith discloses a fastener (16) in combination with an attachment member (18) having a receiving hole (28); the nut includes an attachment part (24) being freely received in the receiving hole and a fitting part (30) which is deformed outward (Figs. 3-5) for retaining the attachment part within the hole and the nut to the attachment member such that the nut engages the attachment member on a first side with a bolt being received from an opposite side. The attachment part has a smaller outside diameter than an inside diameter of the receiving hole (column 2, lines 39-42) and a portion of the nut body adjacent the attachment part abuts the attachment member (see Figs. 5 and 6). Meredith does not disclose the nut as a quick connect nut. Weddendorf discloses a quick connect nut comprising a hexagonal exterior, an inner conical portion (26) including guideposts (57) receiving a plurality of nut segments (41), a stop flange (36) having an aperture and, a spring

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biasing the nut segments. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to make the nut of Meredith a quick connect nut as disclosed in Weddendorf in order to quicken the attachment of the nut onto the terminal post in Weddendorf. The skilled artisan would find the quicker advantageous since it would speed the assembly of the battery cable to the battery terminal by allowing for the cable connector to be simply pushed onto the terminal. Meredith, even as modified by Weddendorf, does not disclose the plurality of fitting pieces. Mehlberg discloses a fastener (1) in combination with an attachment member (8) which are secured together and teaches the equivalence of the securement being provided as a single fitting piece or a plurality of fitting pieces (column 3, line 30-31). At the time the invention was made, it would have been obvious for one of ordinary skill in the art to replace the single fitting piece of Meredith with a plurality of fitting pieces in view of the Mehlberg's teaching that a single and plural fitting pieces are recognized equivalents. Once the combination was made, the spring inherently would automatically inhibit loss of tightening power due to an axial shift of the bolt.

Claims 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meredith (US 5,655,936) in view of Weddendorf (US 5,340,252) and view of Mehlberg (US 5,842,894) as applied to claims 2 and 6 and further in view of Nalle (US 3,104,493). Modified Meredith does not disclose the fitting pieces being arcuate. Nalle discloses a fastener (13) in combination with an attachment member (14) having a receiving hole (18); the nut includes an attachment part (21) being freely received in the receiving hole

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and a plurality of fitting pieces (22). The fitting pieces are formed as four circumferentially spaced arcuate members having an arc of approximately 90° and separated by a distance less than the length of the arc. At the time the invention was made it would have been obvious for one of ordinary skill in the art to form the fitting pieces of modified Meredith in an arcuate shape as disclosed in Nalle in order to increase the area of the fitting pieces and in turn improve the retention of the nut to the attachment member.

Response to Remarks

The rejection of claims over the combination of Nalle and Weddendorf has been withdrawn in response to applicant's amendment(s). Specifically the combination, in particular Nalle, cannot accommodate a bolt inserted at the second end.

In regards to the rejections based on the combination of Meredith in view of Weddendorf and further in view of Mehlberg applicant argues that the combination would not meet the limitations of the claims since in Meredith the nut/attachment member cannot shift axially due to the face that attachment member is fixed in relation to the bolt. In response, the examiner disagrees for two reasons: First, the axial shifting relied upon by applicant is, at best, claimed only as intended use and even at that is not required since limitation is defined only as "in the event of an axial shifting". Therefore, the prior art need only be capable of the responding to the shift should it even happen which in combination with Meredith could occur as the bolt could move

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relative to the battery casing. And second, in Meredith, there *is* an axial shaft as the nut is inserted on the stud.

Also, in regards to rejection based on the combination of Meredith, Weddendorf and Mehlberg, applicant argues that there is nothing contained within the reference which would suggest combining the references to prevent the axial movement and the loss of tightening power. In response, the references need not be combined for the purpose of solving the same problem which applicant is concerned. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

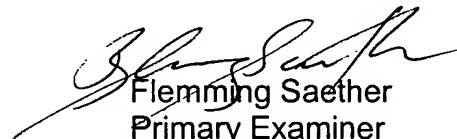
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 571-272-7071. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Flemming Saether
Primary Examiner
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